



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,736	04/09/2004	Lothar Schwink	38005-0197	9019

26633 7590 11/04/2004

HELLER EHRMAN WHITE & MCAULIFFE LLP
1666 K STREET,NW
SUITE 300
WASHINGTON, DC 20006

EXAMINER

HABTE, KAHSAY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/820,736	Applicant(s) SCHWINK ET AL.	
	Examiner Kahsay Habte, Ph. D.	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-4,6,7 and 10-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3 (in part), drawn to benzothiophenes or benzofurans and **E = D = G = L = carbon** (**W** or **U = S/O**, see Examples 118-119), classified in class 549, subclasses 49⁺ and 467.
 - II. Claims 1-3 (in part), drawn to indoles and **E = D = G = L = carbon** (see Example 117), classified in class 548, subclass 469⁺.
 - III. Claims 1-3 (in part), drawn to benzoimidazoles and **E = D = G = L = carbon** (see Example 17), classified in class 548, subclass 304.4⁺.
 - IV. Claims 1-3 (in part), drawn to others (e.g. variables **EDGL** together with the two carbon atoms forms rings such as pyrazines, pyrimidines, pyridines etc. or alternatively variables **UTW** with the benzo ring form benzotriazoles, benzodithiazoles, benzothiazoles etc.), classified in classes 540, 544, 546, 548 and 549, subclass various.
 - V. Claims 4, 6-7 and 10-15, drawn to a composition and method of use of compounds of formula I, classified in class 514, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Group I (benzothiophenes/benzofurans), Group II (indoles), Group III (benzoimidazoles) and Group IV (others) are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of **U**, **W**, **T**, **E**, **D**, **G** and **L** in formula I do not belong to the same recognized class of chemical compounds in the art, and

Art Unit: 1624

references anticipating one invention, would not render obvious the others. Group I is drawn to benzothiophenes/benzofurans (benzene ring fused to a 5-membered ring with one oxygen or with one sulfur) and is different from Groups II-IV, since the core structure contains oxygen or sulfur in the 5-membered ring of the bicyclic ring. Group II is drawn to indoles (benzene fused to a 5-membered ring with one nitrogen) and is different from Groups I and III-IV, since this core structure is not present in other groups. Group III is different from other groups since the core structure contains a benzene ring fused to a 5-membered ring with two nitrogens at 1,3-position that is not present in Groups I-II and IV. Group IV is drawn to others and is different from Groups I-III, since the core structures formed by varying definition of variables **U**, **W**, **T**, **E**, **D**, **G** and **L** in formula **I** form different core structures that are different from the core structures of Group I-III (e.g. **EDGL** forms pyrazines, pyrimidines, pyridines, etc. or alternatively variables **UTW** with the benzo ring form benzotriazoles, benzodithiazoles, benzothiazoles, etc.). Inventions I-IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I (benzothiophenes) has separate utility such as prostate conditions, cardiovascular disorders, impotence etc. (see US Pat. No. 6,780,884). See MPEP § 806.05(d). Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in

Art Unit: 1624

chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other.

If applicants elected Group IV, applicants are required to elect a single disclosed species.

Advisory Rejoinder

2. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

A telephone call was made to Ms. Patricia Grenados on Oct. 20, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9:00AM- 5:30PM).

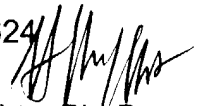
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674, if there is no reply within 24 hours, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

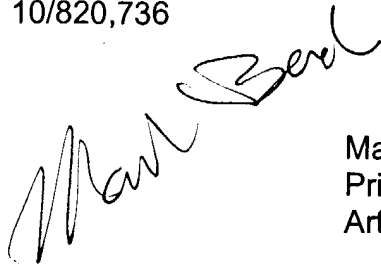
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/820,736

Page 6

Art Unit: 1624


Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mark L. Berch
Primary Examiner
Art Unit 1624

KH
November 1, 2004